

REMARKS/ARGUMENTS

The preceding amendments and following remarks are submitted in response to the Office Action mailed August 9, 2005, setting a three-month shortened statutory period for response ending November 9, 2005. With this Amendment, claims 1 and 23 have been amended and claims 28-29 have been added. Claims 10-22 and 25-27 have been allowed, claims 3, 4 and 6-9 have been objected to, and claims 1, 2, 5, 23 and 24 have been rejected. Reconsideration, examination and allowance of all non-allowed claims are respectfully requested.

Claims 1, 2, 5, 23 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cohen et al.*, U.S. Patent No. 5,167,239 (hereinafter "Cohen") in view of *Dubrul et al.*, U.S. Patent No. 6,602,265 (hereinafter "Dubrul"). To establish a *prima facie* case of obviousness, all of the claim limitations must be taught or suggested by the prior art, and there must be some suggestion or motivation in the prior art to combine the references. See MPEP at §2143.01 and §2143.03. Applicants respectfully assert that a *prima facie* case for obviousness has not been made.

Amended claims 1 and 23 recite, in part, an actuator that is positioned adjacent the stop, where the actuator is moved between a first and second position in order to move a stop between expanded and contracted positions. In contrast to claims 1 and 23, Cohen does not appear to disclose or suggest at least this element. In Cohen, a fluid is pumped into a balloon in order to move the balloon between expanded and contracted positions. This is not an actuator that is positioned adjacent to anything that can be described as a stop as recited in the current claims 1 and 23.

Further, there would be no motivation to modify Cohen by adding an actuating mechanism to the balloon in Cohen. Cohen operates by inflating a balloon in order to anchor a guidewire at a given location. Although Applicants respectfully disagree that the balloon on Cohen is a stop, even if the balloon could function as a stop, the balloon does not have, and would not need, an actuating mechanism positioned adjacent the balloon as recited in the current claims. The inflation mechanism of the Cohen device already accomplishes the task of actuating the balloon. Positioning an actuating mechanism adjacent the balloon in order to provide a mechanism for moving the balloon between expanded and contracted states would be redundant, and thus there would be no motivation to make such a modification of the Cohen reference.

In addition, "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." See M.P.E.P. §2143.01. Cohen already has a mechanism for moving the balloon between expanded and contracted positions, and the mechanism is fluid pressure. Adding or substituting an actuating mechanism operatively coupled to the balloon would significantly change the mode of operation. A device that uses inflation for deployment operates fundamentally differently than using mechanical interaction between an actuator and an actuatable stop for deployment. Thus, regardless of whether a second reference discloses the elements of claims 1 and 23 that are missing from Cohen, there is no motivation to import any such element into the device of Cohen. Importing such a mechanism into Cohen would be redundant and it would change the mode of operation of Cohen, and thus there is no motivation to combine Cohen and Dubrul.

Because Cohen alone does not render independent claims 1 and 23 obvious, and because combining Cohen with another reference in order to provide each and every element of these claims would change the mode of operation of Cohen, Applicants respectfully assert that these claims are not obvious in light of Cohen or the combination of Cohen and Dubrul. Because they are dependent on claims 1 and 23, and because they contain additional patentably distinct elements, Applicants assert that claims 2-9 and 24 are also allowable.

In addition, because they are dependent on claim 1, and because they contain additional patentably distinct elements, Applicants respectfully assert that new claims 28 and 29 are also allowable.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney.

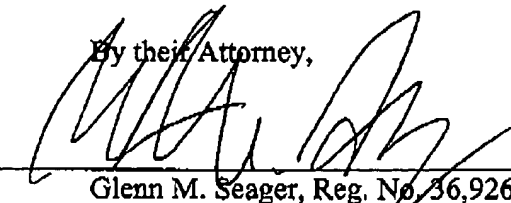
Respectfully submitted,

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By their Attorney,

Date

Nov. 8, 2005



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